

Ms. Kamini Shah, SPE AU 2128
Mr. Thai Phan, Examiner
AU 2128
Jan. 8, 2010

Dear Ms. Shah and Mr. Phan,

I've attempted since 12/17/2009 to reach Ms. Shah without success, and I hope you may still respond to this letter by Monday, the 11th. This letter was originally sent to Ms. Shah's fax number, as well as numerous (>3) followup calls, but I have not heard back to my knowledge.

Attached is a slightly modified version of the letter faxed on 12/17/2009, with some additional appendices for your ease of review.

Essentially, there are some matters of law/regulation that I hope you can address and/or clarify by end of business Monday, 1/11/2010.

Thank you,
Chris Rode
Applicant, PRO-SE
09/287,478
Waltham, MA
02451

AS AMENDED, 1/8/2010

Ms. Kamini Shah
Supervisory Patent Examiner, AU 2128
FAX: 571-273-8300, 571-273-2279

Dear Ms. Shah,

I am the appellant, PRO-SE, for application 09/287,478, examined by Mr. Thai Phan.

Recently, I received another notice of defective appeal brief from the examiner, with consequent dismissal and abandonment, dated 11/12/2009. This was in response to an amended brief filed 9/19/2009 in response to a previous notice of defective brief from examiner filed 05/26/2009. I would like to ask for your review of the following objections made by the examiner.

1) In the notice of 5/26/09 box 5 is checked, referencing 37 CFR 41.37(c)(1)(vi). In the notice of 11/12/2009, box 4 is checked, referencing 37 CFR 41.37(c)(1)(v). In both cases the explanation under section 10 references Section E: Summary of Claimed Subject Matter within the brief, pages 8 and 9, falling under 37 CFR 41.37(c)(1)(v).

Notice of 5/26/2009:

Continuation of 10. Other (including any explanation in support of the above items): On pages 8 and 9 of the appeal, appellant's informal comments are not related to the claims and the rejection of the claims before and during the prosecution. Such comments should not be included in the appeal to make the argument concise for each ground of rejection. The Brief should contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal.

Notice of 11/12/2009:

Continuation of 10. Other (including any explanation in support of the above items): On pages 8 and 9 of the appeal, appellant's informal comments are not related to the claims and the rejection of the claims before and during the prosecution. Such comments should not be included in the appeal to make the argument concise for each ground of rejection. The Brief should contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal.

I have checked MPEP section 1205.02 again, and the requirements do not appear to have changed: items 41.37(c)(1)(v) and 41.37(c)(1)(vi) need not be in compliance for a pro se appellant (page 1200-13):

An exception to the requirement that all the items specified in 37 CFR 41.37(c)(1) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items (i) to (x) specified in 37 CFR 41.37(c)(1) will be accepted as long as it substantially complies with the requirements of items (i) through (iv) and (vii) through (x).

It should be noted that the Notice of 5/26/2009 referred to the brief of 1/23/2008, not the version of 2/18/2008, the version I believe was reinstated by the Office of Petitions (see petition decision 6/23/2008), and that the latter version had a subsection to Section E, entitled "Informal Explanatory Comments", on pages 10 and 11. However, in both the amended briefs of 8/26/2009 and 9/19/2009 these pages were removed and so noted in the cover letter. We spoke briefly a few days after the notice was received here, and my understanding from you is that what is expected in this section a summary of the *independent* claims only, however this doesn't mesh with the examiner's objection since the Summary of Claimed Subject Matter extends from pages 4-9 and includes explanation of dependent claims throughout. A more plausible explanation is that the examiner kept this objection from the previous rejection.

Therefore the examiner's objection is trebly confusing: 1) it objects to a section not required of a pro-se, 2) which box was checked varies from 5/26/09 to 11/12/09 and 3) it is likely the pages it objects to have already been removed. Also, the phrase "Such comments should not be included in the appeal..." is confusing as it seems to refer to the Arguments sections and not the We ask that this objection be removed and if it was the cause for dismissal that the appeal be reinstated.

2) There has been a longstanding dispute over the admissibility of an IDS originally filed 10/19/2005 and this is a central argument of the brief.

In part as followup to a telephone interview of 9/21/2005 and also as applicant's continuing duty to disclose relevant information applicant filed an IDS responsive to examiner's new citation of Lawman 6,324,672 in examiner's non-final rejection of 4/22/2009. The IDS of 10/19/2005 was filed in response to examiner's new citation of Lawman '672, and well before first final of RCE, (by almost 2 months) and so no fee should have been due. A responsive IDS could not have been filed before the RCE, since Lawman had not been cited to that point, as so no fee should have been due.

Per 609.04(b) II (r5):

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection I. above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following:

- a final action under 37 CFR 1.113, e.g., final rejection;
- a notice of allowance under 37 CFR 1.311; or
- an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action,

whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection III.B(5) below); or (2) the fee set forth in 37 CFR 1.17(p)...

After discussions with Mr. Kerry Fries of OPLA, it was determined that a missing affidavit was all that was required, however this was not apparent to me as pro-se in the early-2006 timeframe when this issue was under discussion and as pro-se I was unfamiliar with a section 181 petition to challenge it. An appropriate affidavit was filed (2/19/2008) and accepted as part of the petition to revive from unintentional abandonment (as accepted 6-23-2008). Recently, I have also paid the \$180 fee. Discussions with Mr. Phan had indicated that this IDS would be considered if the fee was paid but this has not happened to the best of my knowledge.

Additional note Jan. 7, 2007: Notice of Defective Appeal Brief of 7/16/2007 again specifically mentions the IDS of 10/19/2005 as not entered for lack of fee (see attached). The Notice of Non-compliant amendment of 5/26/2009 stated:

Continuation Sheet (PTOL-462)

... On page 18, ... The request to consider the IDS statement will be considered as long as it complies with 37 CFR 1.97(d).

Timeline relevant to Lawman ('672) and IDS of 10-19-2005.

12-14-2005	<i>Third Final Rejection - Prosecution closed here</i>
10-19-2005	IDS #4 - The IDS in dispute
09-22-2005	Amendment F to application submitted
09-21-2005	Telephone interview (examiner summary 9-26-2005; applicant 10-19-2005)
04-12-2005	Non-final rejection
01-14-2005	IDS #3A-3D (Filed with RCE)
01-14-2005	RCE
10-22-2004 and 11/18/04	IDS #1 and #2 (These have been entered by examiner 12/27/2004)
07-15-2004	<i>Second Final Rejection</i>
12-15-2003	<i>First Final Rejection</i>

Because the IDS was received before prosecution closed and was responsive to examiner's citation and not known to applicant/appellant more than three months prior to filing, the applicable section of 37 CFR 1.97 should have been c), not d) as posited by Examiner. An appropriate 37 CFR 1.97(e) statement was included with amended appeal brief as received by OIPE on 2/19/2008 (see attached)

The information contained in the IDS was again attached as evidence to the amended brief of 6/26/2009 with a declaration traversing objection or rejection (Appendix I2). Also, as noted in the same brief, a fee of \$180 was included to overcome examiner's objection, in case the delay in submission of the affidavit placed the "effective receipt date" of the original IDS into the post-final category. (as noted on pg. 13 of brief of 6/26/2009, see attached). Examiner does not apparently dispute receipt of this fee.

Instead, there seems to be some unusual activity in the Transaction History after reinstatement (between 6-23-08 and 7-22-08) with regard to the IDS filed 11-18-2004, but that is not the relevant IDS. In fact, the 11-18-2004 IDS had already been entered by examiner in the December

2004 timeframe and a fee was paid at that time. If the 11-18-2004 IDS was mistakenly re-entered in place of a first entry for the 10-19-2005 IDS, this creates a problem with the appeal as unentered evidence cannot be referenced in an ordinary brief. However, I am appealing the non-entry of the information and so I must reference it.

Regardless of the deficiency of affidavit or fee, the information was plainly relevant evidence with respect to citation of Lawman with respect to examiner's rejection of 4/22/2009, as explained verbally and in writing and so it should never have proceeded to final rejection without a resolution of this issue, particularly for a pro-se first application. Therefore, I have included the disputed IDS evidence, which if allowed intrinsically obviates examiner's objection to it ("On pages 12-13...Xilins' (sic) citation and Webmaster as well". Also, "On page 18, appellant argued Lawman patent does not work... On page 26... claims involved in the appeal.")

3) With respect to "In Ground 5, on page 12...", there is no longer any Ground 5 as noted in the cover sheet. There is only a Ground 2. This is further evidence that the examiner was referring to the older brief or perhaps just copying his arguments from the previous Notice of Non-Compliant Appeal Brief.

4) There is, however, an error correctly noted by the examiner, in the 3 time misused "Lawson (5,950,201)" where "Van Huben (5,950,201)" was meant ("On pages 15-17..."). This has been corrected in a newly amended brief but constitutes a new objection and therefore not grounds for dismissal, I believe.

Sincerely,
Christian S. Rode
Applicant, PRO-SE, 09/287,478
Waltham, MA 02451
781-899-4322



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09287478	4/6/99	RODE, CHRISTIAN STIG	RCI001V1

RODE CONSULTING, INC.
6209 STEARNS HILL RD.
WALTHAM, MA 02451

EXAMINER

Thai Phan

ART UNIT	PAPER
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2128

20070708

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The Information Disclosure Statement filed in the Brief on 03/15/2007 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered. Attached is a Notification of Non-Compliant Appeal Brief.

Thai Phan

THAI PHAN

PRIMARY EXAMINER
TECHNOLOGY CENTER 2100



Statement by Inventor/Applicant Christian S. Rode

Application Number: 09/287,478

Filed: 4/6/1999

Inventor Docket: RCI001V1

Date of this letter: 02/17/2008

STATEMENT UNDER 37 CFR 1.97(e)

For Information Disclosure Statement Filed 10/19/2005

"No item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement." The internet searches that located this material were performed from 9/22/2005 through 10/19/2005, the date of the filing of the IDS.

The IDS has been incorporated into the file wrapper but not entered by the examiner "for non-payment of fee". However, as part of the duty to continuously disclose and in direct response to the examiner's citation of Lawman as prior art and the IDS was filed within three months of discovery of this material so no fee is due under MPEP 609.04(b)(2).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Signature of Inventor

Printed Name of Inventor

Christian S. Rode

Date

2/17/2008

Pursuant to MPEP 1206 II(B) and 37 CFR 41.31(a) appellant requests that the previously submitted IDS be entered pre-appeal brief for the following reasons.

- 1) The original IDS was timely filed and in response to the examiner's citation of the Lawman ('672) patent.
- 2) It is relevant because the documentation from Xilinx's own website demonstrates a limitation overcome by the present invention
- 3) It is relevant because Xilinx was an indirect client (via ChipCenter, LLC) for the present invention.

4) The continual request for payment of a fee was a red herring for myself as PRO-SE. I kept explaining that since it was newly discovered no fee was due. The correct response from the examiner should have been that no fee was do but "Either a fee is due OR a statement under 37 CFR 1.97(e) that the information was discovered no earlier than three months prior to the filing of the statement".

5) During an earlier conversation (not memorialized), Examiner agreed it was appropriate.

Signature of Inventor

CSR

Printed Name of Inventor

Christian S. Rode

Date

2/11/2008

information during the writing of his response to the examiner's citation and so met the standard of 37 CFR 1.97(e)(2).

Applicant ultimately gave up trying to get Examiner to acknowledge the facts of 609.04(b)(2), and due to increasing fatigue did not pursue again except on Appeal, where it was attempted to be reinserted as evidence in direct reponse to Examiner's citation of the prior art. Examiner apparently maintains that an IDS fee is due even under 1.132.

Regarding the web citations, I have recently made Attested True Copies of at least one documents still available today on Xilinx's site. Others, despite an 8 year presence on the Xilinx site, have been recently removed and contact with Xilinx's webmaster indicates they may not be retrievable, an argument I find dubious. Nonetheless, I maintain copies of the PDFs as downloaded in Oct. 2005 and can produce Attested True copies if needed, but I think this is of diminished probative value. I continue to look for paper or other copies from an independent source.

Lawman is important for these reasons:

- 1) They function by means of a TCP/IP socket even within a web browser and so are part of the prior art that the present invention was designed to supercede. In particular, connectivity via a web proxy server is not possible.
- 2) They were an indirect customer of Rode Consulting, Inc. for the technology of the present invention. They were the sponsor of a site on ChipCenter, LLC, that made use of the invention, demonstrating commercial success, and long-felt need as the disclosed documents indicate an inability to perform through proxy servers.

Nevertheless, I have included the fee of \$180 in the interest of moving the case forward, and wish to appeal to have it refunded as unnecessary and perhaps defective.

(GROUND/ARGUMENT 5 WITHDRAWN)

Ground 3.

Arguments in the amended Appeal Brief of 3/15/2007 relative to 37 CFR 41.37(vii) may already have substantially complied for a non-registered-practitioner. It has been difficult to identify the relevant MPEP sections and case-law for each argument in favor of non-obviousness as a PRO-SE and the Appellant is still working to improve these sections. General arguments against non-obviousness have typically been capitalized. My understanding is that this meets the burden of "substantial compliance" for self-represented persons.

Ground 4.

Ground 4 concerns evidence presented in rebuttal of examiner's citation of Lawman (6,324,672) as prior art. This evidence was originally submitted as an IDS on October 19th 2005 after Appellant's response of Sep. 22nd, 2005, but before Examiner's Final Office Action of Dec. 14, 2005, as an IDS pursuant to 609.04(b)(2) – an information disclosure filed within an RCE but before final but without a 37 CFR 1.97(e) statement that the information only became known to the Applicant 3 months prior to the filing. Applicant only went searching for this information during the writing of his response to the examiner's citation.

Applicant repeatedly communicated (verbally, unfortunately) to examiner that the IDS had been filed within 3 months of discovery (9/22/2005 vs. filing on 10/19/2005) and so no fee was due (609.04(b)(2)), but examiner insisted a fee was due for such a filing. Applicant was unaware of the missing 37 CFR 1.97(e) statement and examiner never communicated this, insisting in his Final Action (and informal calls) that the IDS was rejected due to nonpayment of a fee.

"The information disclosure statement filed 10/19/2005 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered."

Office Action of 12/14/2005, pg. 2

Although Applicant was unaware of what this meant at the time, these rules appear to apply to a post-Final IDS necessitating new grounds of rejection, when the submission was nearly two months prior to Final and within one month of an interview with the examiner (9/21/2005), essentially contemporaneous with the filing of that summary and so before any action could have been taken by the examiner. That is, it is impossible for the IDS submitted 10/19/2005 to have been a post-Final IDS. Objectively, the Examiner was correct not to enter the IDS, but not for the grounds given, which is misleading for a pro-se, who will naturally defer to the examiner during their first pro-se application prosecution. After the Final office action was received and since more than three months had passed, applicant came to believe that only a appeal would compel the examiner to consider the IDS, and so included it in the evidentiary appendix under 37 CFR 1.132 as evidence in direct response to Examiner's citation of the prior art. Applicant has now also included a 37 CFR 1.97(e) statement, which, in addition to the already-filed 1.132 statement that appeared in the evidence appendix (Appendix I2) of the briefs (including that of March 15, 2007), should compel entry by examiner under 37 CFR 41.33/1.

An additional element may be use of the word "considered" instead of "entered", as any difference or similarity would not be appreciated by a pro-se during a first prosecution. Applicant is still not certain as to what the difference may be, but because the information had been "placed in the application file" and available in the wrapper, applicant assumed it could be referred to in the appeal brief(s). Disentangling incorrect or misleading legal reasoning presents an unreasonable burden to a pro-se. The reasons the IDS should be entered now is that 1) the reasoning given for rejection of the IDS was not correct, 2) it did not need to be an IDS at all since it was plainly evidence traversing a rejection and the examiner had been so advised during a preceding interview (and so should have been either entered or noted to Applicant), and 3) admitting the evidence contained therein will remove Lawman from the cause of rejection and so permit allowance of all claims.

The importance of the issue is that Xilinx's own technical support documentation states that their invention will not work through corporate firewalls, as it requires socket communication (TCP/IP) through a firewall, instead of using the HTTP proxy functionality (see IDS submission of 10/19/2007, first item "LogicCORE PCI – Error: "XPCICORE Generator Server transaction failed, Failure-cause:1097...", Solution 1, "... 1. Verify with your system administrator that the firewall does not block socket connections."). HTTP, while a layer built on top of TCP/IP, works in a fundamentally different way. Java applets have the ability to communicate with their server, either using TCP/IP or by HTTP. The applicant has conceded that TCP/IP-based internet CAD tools were a known prior art, and has been at pains to explain what is novel, useful and non-obvious about the present invention relative to that art.

Regarding these web citations, I have recently had made Attested True Copies by a third party of at least one document still available today on Xilinx's site. Others, despite an 8 year presence on the Xilinx site, have been recently removed and contact with Xilinx's webmaster indicates they may not be retrievable, an argument I find dubious. I maintain copies of all PDFs as downloaded and can produce Attested True copies (attested by me) if needed. I continue to look for paper or other copies from an independent source.

In summary, the admission of evidence v. Lawman ('672) is important for these reasons:

- 1) It demonstrates that the Lawman invention requires a TCP/IP socket even when invoked by a web browser and so forms a continuum with the prior art that the present invention was designed to supersede. In particular, connectivity via a web proxy server is not possible.
- 2) It intrinsically supports non-obviousness as an example of "Failure of Others" to overcome a problem, in this case, that of proxy-server compatibility.
- 3) Xilinx was an indirect customer of Rode Consulting, Inc (party in interest). for the technology disclosed in the present invention. They were the sponsor of a site on ChipCenter, LLC, that made use of the